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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,322	01/14/2002	Riichiro Abe	9511-087-27	6656

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Supervisor, Patent Prosecution Services  
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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/043,322

Applicant(s)

ABE ET AL.

Examiner

Christopher H Yaen

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/17/04 & 8/21/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

**RE: Abe et al**

**Priority Date: 12 January 2001**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I in the reply filed on 6/4/2004 is acknowledged. The traversal is on the ground(s) that the restriction requirement was improper and that a search for the different groups would not be unduly burdensome. This is not found persuasive because the different groups are all drawn to different and distinct inventions all of which are classified in different classes and subclasses. Moreover, the inventions of the different groups require searches in different databases which do not constitute searches of similar subject matter and hence would not be overlapping nor co-extensive.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-20 are pending, and claim 20 is newly added.
3. Claims 1-11 and 20 are withdrawn from further consideration as being drawn to a non-elected invention. Claim 20 is withdrawn from further consideration as being drawn to a non-elected invention, had it been presented earlier, the claim would have been subject to restriction because the claim is drawn to a different and distinct invention.
4. Claims 12-19 are therefore examined on the merits.

### ***Information Disclosure Statement***

5. The Information Disclosure Statement filed 8/21/2002 and 6/17/2004 are acknowledged and considered. A signed copy of the IDS is attached hereto.

***Specification***

6. The disclosure is objected to because of the following informalities: the specification at page 22 for improper disclosure of amino acid sequences without a respective sequence identifier, i.e. a SEQ ID NOs. Hence, the disclosure fails to comply with the requirements of 37 CFR 1.821 through 1.825. In the absence of a sequence identifier for each sequence, Applicant must provide a computer readable form (CRF) copy of the sequence listing, an initial or substitute paper copy of the sequence listing, as well as any amendment directing its entry into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e-f) or 1.825(b) or 1.825(d). Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-6, as written, do not sufficiently distinguish over cells as they exist naturally because the claims do not particularly point out any non-naturally occurring differences between the claimed products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered non-statutory subject matter. *See Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193

Art Unit: 1642

(1980). The claims should be amended to indicate the hand of the inventor. See MPEP 2105.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 12-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description in this case has set forth a cellular composition comprising CD8<sup>+</sup> T-cells incubated with an anti-MIF antibody, and further comprising a tumor antigen derived from a thymoma, and therefore the written description in this case is not commensurate in scope with claims that read on a cellular composition comprising any cell incubated with an anti-MIF antibody and further comprising any tumor antigen.

*Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117). The specification does not “clearly allow persons of

Art Unit: 1642

ordinary skill in the art to recognize that [he or she] invented what is claimed."

(See *Vas-Cath* at page 1116). Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC 112 is severable from its enablement provision (see page 115).

The claims recite "cells" and "tumor antigen", as part of the invention. However, there does not appear to be an adequate written description in the specification as-filed of the essential structural feature that are representative of the broad class of cells and tumor antigens claimed. The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 3<sup>rd</sup> column).

Applicant does not appear to have reduced to practice the broad genus of cells and or tumor antigen claimed. Neither has Applicant provided a sufficient written description of any structure, or species that is representative of the broad classes of cells or tumor antigen claimed. The specification has only taught a cellular composition comprising CD8<sup>+</sup> T-cells that have been stimulated by a

Art Unit: 1642

tumor antigen associated with an EL4 cell (derived from a thymoma) that has been transfected with a vector expressing ovalbumin (see pages 25-31 of the specification). A "cell" or "tumor antigen" encompasses a genus of distinct and divergent structures all of which is not represented by any all encompassing species. Thus the genus of cells and antigen encompassed by these terms is extensive and the artisan would not be able to recognize that Applicant was in possession of the invention as now claimed.

Consequently, Applicant was not in possession of the instant claimed invention. See Regents of the University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997). Adequate written description of genetic material "requires a precise definition, such as by structure, formula, chemical name, or physical properties,' not a mere wish or plan for obtaining the claimed chemical invention." Id. 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter of the claim. Id. 43 USPQ2d at 1406. A description of what the genetic material does, rather than of what it is, does not suffice. Id.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001. Applicant is invited to point to clear support or specific examples of the claimed invention in the specification as-filed.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12,14, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Calandra *et al* (Proc. Natl. Acad. Sci. USA 1998 September; 95:11383-11388). Calandra *et al* teach a cellular composition comprising splenocyte cells incubated ex vivo with an anti-MIF antibody in the presence of TSST-1(see page 11384, right col.). Because it is taught that TSST-1 induces the T-cell activation (see page 11386 left col.), the incubation of the splenocytes with the TSST-1 would make the cellular composition into T-cells, and because the office does not have the facilities to determine if the cells taught by Calandra *et al* are as claimed, in the absence of evidence to the contrary, the T-cells would be CD8<sup>+</sup>.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under



Art Unit: 1642

the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 12,14, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Bucala *et al* (US Patent 6,645,493).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bucala *et al* teach a cellular composition comprising splenic T-cells incubated ex vivo with an anti-MIF antibody (see col. 41, lines 35-38). Further, because T-cell are considered immune cells, claims reciting limitations to "immune cells" are also anticipated. In addition, because the office does not have the facilities to determine if the T-cells are CD8<sup>+</sup>, in the absence of factual evidence to the contrary, the T-cell taught by Bucala *et al* are CD8<sup>+</sup>.

### **Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

Art Unit: 1642

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen  
Art Unit 1642  
August 3, 2004



**GARY NICKOL**  
**PRIMARY EXAMINER**